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BRINKS  
HOFFER  
GILSON  
& LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Patrick J. Walsh  
Appln. No.: 10/686,553  
Filed: October 14, 2003  
For: Location Privacy Manager for a Wireless  
Communication Device and Method  
Thereof

Examiner: Nguyen, David Q.  
Art Unit: 2681

Attorney Docket No: 8285-646

Mail Stop AF  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

Attached is/are:

- ☒ Transmittal Letter (in duplicate); Pre-Appeal Brief Request for Review (5 pages); Pre-Appeal Brief Request for Review (PTO form) (1 sheet)
- ☒ Return Receipt Postcard.

Fee calculation:

- ☐ No additional fee is required.
- ☐ Small Entity.
- ☐ An extension fee in an amount of \$\_\_\_\_\_ for a \_\_\_\_\_-month extension of time under 37 C.F.R. § 1.136(a).
- ☐ A petition or processing fee in an amount of \$\_\_\_\_\_ under 37 C.F.R. § 1.17(\_\_\_\_\_).
- ☐ An additional filing fee has been calculated as shown below:

					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			x \$100=			x \$200=	
First Presentation of Multiple Dep. Claim					+ \$180=			+ \$360=	
					Total	\$		Total	\$

Fee payment:

- ☐ A check in the amount of \$\_\_\_\_\_ is enclosed.
- ☒ Please charge Deposit Account No. 23-1925 in the amount of \$500.00. A copy of this Transmittal is enclosed for this purpose.
- ☐ Payment by credit card in the amount of \$\_\_\_\_\_ (Form PTO-2038 is attached).
- ☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

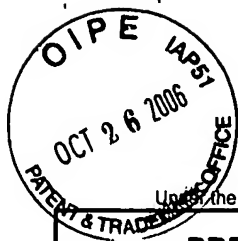
10/30/2006 AWONDAF1 00000061 231925 10686553  
01 FC:1401 500.00 DA

Respectfully submitted,

October 26, 2006  
Date

Scott W. Brim (Reg. No. 51,500)

BRINKS  
HOFFER  
GILSON  
& LIONE



# PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional) 8285-646

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail 906856484US in an envelope addressed to: "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" (37 CFR 1.8(a)).

On October 26, 2006

Signature

Typed or printed

Name Scott W. Brim

Application Number  
10/686,553

Filed October 14, 2003

First Named Inventor Patrick J. Walsh

Art Unit  
2681

Examiner  
Nguyen, David Q.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five(5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 51,500

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34.           

  
Signature

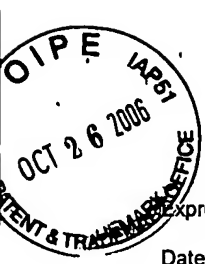
Scott W. Brim  
Typed or Printed Name

312 321-4200  
Telephone number

Note: Signatures of all inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.\*

October 26, 2006  
Date

☒ \*Total of 1 forms are submitted.



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Attorney Docket No. 8285/646

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
Patrick J. Walsh	)	
	)	Examiner: Nguyen, David Q.
Serial No.: 10/686,553	)	
	)	Group Art Unit No.: 2681
Filing Date: October 14, 2003	)	
	)	
For: Location Privacy Manager for a	)	
Wireless Communication Device	)	
and Method Thereof	)	

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandra, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejection in the above-identified application.

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## **I. Introduction**

Claims 1-12, 19, 21, and 23-25 are pending in the application. In the final Office Action dated July 26, 2006, the Examiner rejected claims 1, 6, 11-12, 19, 21, 23, and 25 under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,675,017 ("Zellner"). Further, claims 2-5, 7-10, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zellner in view of U.S. Pat. No. 6,442,391 ("Johansson"). Applicant respectfully requests review of the final rejection.

## **II. Zellner Does Not Teach Allowing a Remote Source to Know Either an Identity or a Location of a Wireless Communication Device While Prohibiting the Remote Source from Knowing Both the Identity and Location of the Wireless Device**

Independent claim 1 recites the action of allowing a remote source to know either an identity or a location of a wireless communication device while prohibiting the remote source from knowing both the identity and location of the wireless communication device. Zellner fails to disclose at least this element of claim 1.

Zellner is directed to a system that provides a location blocking service for use in a wireless network. In the final Office Action, the Examiner asserted that Col. 4, lines 20-37 and Col. 6, lines 3-30 disclose allowing a remote source to know either an identity or a location of a wireless communication device while prohibiting the remote source from knowing both the identity and location of the wireless communication device. Applicant respectfully disagrees. In Zellner, the only discussion regarding actions of the Zellner system and an identify of a wireless device discusses blocking both an identity and a location of the wireless device such that the remote source would not know either an identity or a location of the wireless device. (Col. 4, lines 20-37, Col. 8, lines 50-65). In fact, in the Office Action dated January 23, 2006, the Examiner cited Zellner for the teaching of prohibiting a remote source from knowing both an identify and a location of the wireless device. (See Office Action dated Jan. 23, 2006, page 3). In other words, because the only actions of the Zellner system regarding an identity of a wireless device involving blocking both an identity and a location of the wireless device, it would not be possible to at the same to know either an identity or a location of the wireless device.

Because Zellner fails to disclose at least the action of allowing a remote source to know either an identity or a location of a wireless communication device while prohibiting the remote source from knowing both the identity and location of the wireless communication device in response to determining the wireless device approves of the remote source, Zellner cannot anticipate independent claim 1, or any claim that depends on claim 1. Applicant respectfully requests review of the final rejection.

### **III. Zellner Does Not Anticipate Independent Claim 19 and 21**

Independent claims 19 and 21 recite the action of allowing a remote source to know either an identity or a location of a wireless communication device while prohibiting the remote source from knowing both the identity and location of the wireless communication device in response to determining the wireless device approves of the remote source. As discussed above, Zellner fails to disclose at least this element. For at least this reason, Zellner cannot anticipate independent claims 19 and 21. Applicant respectfully requests review of the final rejection.

### **IV. Zellner Does Not Anticipate Independent Claims 23 and 25**

In the section of the Office Action regarding the rejections under 35 U.S.C. § 102(e), the Examiner asserts that Zellner discloses each element of claims 23 and 25. However, in the section of the Office Action regarding the rejections under 35 U.S.C. § 103(a), the Examiner admits that “Zellner et al. does not mention the step of managing further comprising: receiving a request for location information associated with the wireless communication device from the remote source; determining whether or not the wireless communication device approves of the remote source in response to receiving the request for location information; sending the location information to the remote source in response to determining that the wireless communication device approves of the remote source.” Independent Claims 23 and 25 include elements similar to those the Examiner has admitted that Zellner fails to disclose. Applicant respectfully requests review of the final rejection.

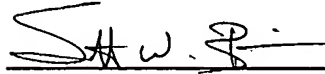
**V. The Examiner Has Admitted that Zellner Fails to Disclose Prohibiting a Device From Knowing Both an Identifier and a Location of a Wireless Communication Device**

As discussed above, Zellner fails to disclose the action of allowing a remote source to know either an identity or a location of a wireless communication device while prohibiting the remote source from knowing both the identity and location of the wireless communication device in response to determining the wireless device approves of the remote source. The Examiner has previously admitted, "Johanson never mentions or disclose prohibiting a device from knowing both an identifier and a location of a wireless communication device." (See Office Action dated Sept. 20, 2005, page 3). Thus, Johansson necessarily cannot disclose the action of allowing a remote source to know either an identity or a location of a wireless communication device **while prohibiting the remote source from knowing both the identity and location of the wireless communication device** in response to determining the wireless device approves of the remote source as recited in claim 1. Due to the fact Zellner and Johansson both fail to disclose at least this element, the proposed combination of Zellner and Johansson as contemplated by the Examiner necessarily cannot render claim 1, or any claim that depends on claim 1, unpatentable. Applicant respectfully requests review of the final rejection.

**VI. The Proposed Combination Does Not Render Claim 23 Unpatentable**

Independent claim 23 recites the elements of managing communication between a wireless communication device and a remote source to prohibit the remote source from knowing both an identity and a location of the wireless communication device, and sending location information to the remote source. As discussed above, Zellner and Johansson both fail to disclose at least managing communication between a wireless communication device and remote source to prohibit the remote source from knowing both an identity and a location of the wireless communication device while sending location information to the remote device. For at least this reason, the proposed combination of Zellner and Johansson as contemplated by the Examiner does not render independent claim 23, or any claim that depends on claim 23, unpatentable. Applicant respectfully requests review of the final rejection.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "S.W. Brim", is positioned above a horizontal line.

Scott W. Brim  
Registration No. 51,500  
Attorney for Applicants

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